

## **REMARKS**

Reconsideration and withdrawal of the rejections set forth in the Office Action dated September 10, 2004 are respectfully requested. A separate petition for a one month extension has been enclosed.

By this amendment, claims 1, 20, 30, and 40-42 are amended.

The attorneys for the applicants wish to thank the Examiner for the examination, and particularly for the detailed Office Action and citations to relevant portions of the applied references. The applicants respectfully believe that the claims are patentable for the following reasons.

### **I. Applicant's Technology**

Embodiments of the invention disclose a method for transmitting content from a WAP/i-mode-enabled device to a destination device, which may or may not also be a WAP/i-mode-enabled device. For example, you may have accessed a URL via your wireless device and obtained movie times to various movie theaters on your wireless device display. You may now want to tell other friends these times without manually writing down the information and calling each friend. Under one aspect of the invention, the content displayed on your wireless device display may be effectively cut and pasted into a message, or a link to that content provided in the message, where that message can then be shared with others.

Content, or a URL corresponding to the content, which has been accessed by a WAP/i-mode-enabled device, may be first transmitted to an application server. This WAP/i-mode-enabled device may also transmit a destination address for the content to the application server. The destination address corresponds to another WAP/i-mode-enabled device, a fax machine, or other telecommunication device with which the WAP/i-mode enabled device wishes to share the content that it has accessed.

In one embodiment, the application server transmits to the destination address the URL or a related/re-formatted URL or pointer corresponding to the content. The URL can be used to access the content by the receiving device associated with the destination address. Independent claims 1, 20, and 40 are directed to this embodiment.

In an alternate embodiment, the application server fetches the content at the URL and stores it in a cache. The application server may then send the content to the device associated with the destination address. Independent claims 30, and 42, among others, are directed to this embodiment. Alternatively, the application server may create a modified URL or pointer to the content stored in the cache, and send this modified URL/pointer to the destination device. The application server then retrieves and transmits the content to the destination device when the destination device accesses the modified URL/pointer. Independent claims 1, 19, 20, and 41 are directed to this embodiment. The content stored in the cache may be identical to, or modified from, the original content accessed by the WAP/i-mode device via the original URL.

## **II. Rejections under 35 U.S.C. § 102**

Claims 1-8 and 15-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Nykanen (U.S. Patent No. 6,661,784).

### **A. The Applied Art**

U.S. Patent No. 6,661,784 to Nykanen (*Nykanen*) is directed to a method for setting up a data transmission connection which is formed to transmit information between a first communication device and a second device. A network address is used to identify the first communication device, which is WAP-enabled. *Nykanen* further discloses a method for enabling communication between the first communication device and the second device. *Nykanen* fails to disclose a method for sharing or storing data that is transmitted from the device.

## B. Analysis

Distinctions between independent claims 1, 19, 20, 30, 40, 41, and 42, and *Nykanen* will first be discussed, followed by distinctions between *Nykanen* and the remaining dependent claims.

As noted above, *Nykanen* discloses a method for establishing data transmission between two devices, but fails to disclose a method for sharing content transmitted from a wireless device. Embodiments of the invention extend the concept of facilitating data transmission between two communication devices disclosed in *Nykanen* by providing a method for storing and sharing content transmitted from a device. In other words, embodiments of the invention pick up where *Nykanen* leaves off: *Nykanen* discloses how to establish a connection and obtain data/content via a WAP device, while embodiments of the invention explain how to then share that data/content with another device.

Independent claims 1, 19, 20, 30, 40, 41, and 42 recite, among other limitations, techniques for sharing content transmitted from a WAP/i-mode-enabled device. More specifically, claim 1 has been amended to recite a method for transmitting content from a first WAP/i-mode-enabled device to a second WAP/i-mode-enabled device in which a message including an indication of the second URL, which corresponds to content at a first URL accessed by the first device, is transmitted to a destination address for the second device. The second device may thereby assess the content via the message. *Nykanen* fails to disclose any such sharing of content, accessed by a first device, with a second device.

Claim 20 recites limitation similar to claim 1, and further recites, *inter alia*, generating a message including a pointer to a second URL, wherein the pointer, second URL, or both relate to data accessible via the first URL. *Nykanen* further lacks such a disclosure. Instead, *Nykanen* discloses a method for generating “datagrams, i.e. data packets containing the destination address and the information to be transmitted.” Column 8, lines 63-64. However, a pointer by definition references a storage location but does not contain the actual information stored at that location. Therefore, a pointer is different from

a "datagram." Claim 41 recites similar limitations. For at least these reasons, claims 20 and 41 are patentable over *Nykanen*.

Claims 30 and 42 recite, among other limitations, storing the content (or modified version of the content) to be shared between devices, and generating a message including the content itself. *Nykanen* fails to disclose such a method for storing and sharing content accessed from a WAP/i-mode-enabled device to another device.

Claim 19 recites, among other limitations, effectively storing a modified version of the content to be shared between devices, and generating a message including an indication of a second URL for the content itself. Specifically, the method of claim 19 includes generating "a file associated with the second URL including a modified version of the content corresponding to the first URL." *Nykanen* lacks any such disclosure.

*Nykanen* also fails to disclose a method for transmitting content from a device that is "WAP and i-mode-enabled or just i-mode-enabled." I-mode refers to a type of packet-based information service for mobile phones that allows information and e-mail to be delivered to the mobile phones. Instead of disclosing a method for transmitting content from an i-mode-enabled device, *Nykanen* discloses only a method for transmitting content from a WAP-enabled device. Column 12, lines 25-31. Claim 42 recites, among other limitations, a method for transmitting content from a device that is "WAP and i-mode-enabled or just i-mode-enabled." *Nykanen* fails to disclose such a method for transmitting content from an i-mode-enabled device. For at least this additional reason, claim 42 is patentable over *Nykanen*.

For at least the above reasons, independent claims 1, 19, 20, 30, 40, 41, and 42 are patentable over *Nykanen*.

As is known, to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim.<sup>1</sup> *Nykanen* fails to disclose every limitation recited in claims 1,

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<sup>1</sup> MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). See also, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995)

19, 20, 30, 40, 41, and 42. Since claims 1, 19, 20, 30, 40, 41, and 42 are allowable, based on at least the above reasons, the claims that depend on claims 1, 19, 20, 30, 40, 41, and 42 are likewise allowable. Thus, for at least this reason, claims 2-8, 15-18, 21-29, and 31-39, in addition to claims 1, 19, 20, 30, 40, 41, and 42, are patentable over *Nykanen*.

### **III. Rejections under 35 U.S.C. § 103**

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nykanen* (U.S. Patent No. 6,661,784) in view of *Osaku et al.* (U.S. Patent No. 6,061,738, herein "*Osaku*").

#### **A. The Applied Art**

U.S. Patent No. 6,061,738 to *Osaku et al.* (*Osaku*) is directed to methods and systems for accessing a network URL through a pre-assigned simplified network address, correlating to the URL, and for displaying the home page having the URL as its address.

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(anticipation requires that each claim element must be identical to a corresponding element in the applied reference); *Atlas Powder Co. v. E.I. duPont De Nemours*, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference").

## B. Analysis

### The Applied References Even if Combined, Fail to Disclose or Suggest the Claimed Invention.

As noted above, *Nykanen* discloses a method for setting up a data transmission connection between two communication devices, and *Osaku* discloses methods and systems for accessing a network URL. Both *Nykanen* and *Osaku* fail to disclose a method for sharing content transmitted from a WAP/i-mode-enabled device as recited in claim 1. Since claim 1 is allowable, based on at least the above reasons, the claims that depend on claim 1 are likewise allowable. Thus, claims 9-14 are patentable over the combination of *Nykanen* and *Osaku*.

### The Applied References Lack a Specific Suggestion to Combine Them As Argued in the Office Action

Independent claims are allowable not only because they recite limitations not found in the references (even if combined), but for at least the following additional reasons. For example, there is no motivation to combine the various references as suggested in the Office Action. According to the Manual of Patent Examining Procedure ("MPEP") and controlling case law, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, but instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, in 2002, the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and thus overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two references.<sup>2</sup> The MPEP provides similar instructions.<sup>3</sup>

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<sup>2</sup> In re Sang-Su Lee, 277 F.3d 1338, 1341-1343 (Fed. Cir. 2002).

Conversely, and in a manner similar to that rejected by the Federal Circuit, the present Office Action lacks any description of a motivation to combine the references from the references themselves. Thus, if the current rejection is maintained, the applicant's representative requests that the Examiner explain with the required specificity where a suggestion or motivation in the references for so combining the references may be found.<sup>4</sup>

As is known, one may not use the application as a blueprint to pick and choose teachings from various prior art references to construct the claimed invention ("impermissible hindsight reconstruction").<sup>5</sup> Assuming, for argument's sake, that it would be obvious to combine the teachings of *Nykanen* with *Osaku*, then *Nykanen* would have done so because it would have provided at least some of the advantages of the presently claimed invention. *Nykanen*'s failure to employ the teachings cited in *Osaku* is persuasive proof that the combination recited in claim 1 is unobvious. For at least this reason, the applicant believes that claim 1 is patentable over the combination of *Nykanen* and *Osaku*.

#### IV. Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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<sup>3</sup> Manual of Patent Examining Procedure, Section 2143 (noting that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure," citing *in re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

<sup>4</sup> See, MPEP Section 2144.03.

<sup>5</sup> See, e.g., *In re Gorman*, 933 F.2d 982,987 (Fed. Cir. 1991), ("One cannot use hindsight construction to pick and choose between isolated disclosures in the prior art to deprecate the claimed invention.").

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 101948075US1 from which the undersigned is authorized to draw.

Dated:

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